

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(S): LEE, Jong-Goo, et al.

ART UNIT: 2179

APPLICATION NO.: 10/743,476

EXAMINER: THERIAULT, Steven B.

FILED: December 23, 2003

DATED: December 8, 2008

FOR: PROACTIVE USER INTERFACE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Sir:

In response to the Examiner's Answer having a mailing date of October 7, 2008, Appellants respectfully submit that based on at least the arguments provided in the Appeal Brief of July 7, 2008, Claims 1-7 and 109-141 are patentable over the applied reference. The following comments are respectfully submitted to address statements made in the Examiner's Answer.

The allegations raised in the Examiner's Answer do not change the fact that Claims 1-7 and 109-141 are patentable over U.S. Patent No. 6,400,996 to Hoffberg et al. (herein "Hoffberg").

1. The Alternative Embodiments of Hoffberg Cited in the Examiner's Answer Fail to Anticipate the Pending Claims

The Examiner's prior analysis relied upon Fig. 15 and 16 of the 143-page Hoffberg reference, aside from an extensive listing of patents that Hoffberg 'incorporates by reference,' which is discussed in Section 2 below. The Examiner's Answer adds an analysis of embodiments discussed at Col. 97-98 and at Col. 100, lines 1-21. Like the originally cited embodiment of Figs. 15-16 of Hoffberg, these new embodiments also fail to disclose *proactively altering at least one function of said interface unit according to said detected pattern*, and accordingly do not anticipate any of Claims 1-7 and 109-141 under 35 U.S.C. § 102(b).

Fig. 15 of Hoffberg discloses a process to "eliminate extra keypresses" by providing to the user "[f]requently used choices for program selection." (Hoffberg, Col. 85, lines 16 and 18-19.) The Examiner incorrectly alleges that a "skilled artisan would determine that a reprogramming of the interface is an altering of at least one function of the interface" to be taken "[i]n combination with cited features of tracking and modifying the interface." (Examiner's Answer, bottom of page 7.) The Examiner also incorrectly argues that a "behavior of use" pattern" allegedly disclosed in Figs. 15-16 of Hoffberg can be taken "[i]n combination with the description of the interface example in column 97-98" of Hoffberg (Examiner's Answer, bottom of page 7 to top of page 8).

To the contrary, "Example 5" of Hoffberg functions "[b]y determining the skill of the user" (Hoffberg, Col. 97, lines 65-66) and accordingly differs from the embodiment(s) of Figs. 15-16. Moreover, the "Example 5" discussed at the newly cited Col. 97-98 of Hoffberg is not expressly related to the example of Figs. 15-16, and the Examiner improperly seeks to combine such alleged disclosure from different embodiments in an anticipation rejection. The need for the

Examiner to cite various aspects of different embodiments highlights the Examiner's inability to satisfy the requirement of showing how Hoffberg describes all of the elements of the claimed invention, arranged as in the pending claims. See, *Net MoneyIN, Inc. v. VeriSign, Inc.*, 2008 U.S. App. LEXIS 21827, *22 (2007-1565 Oct. 20, 2008), in which the Federal Circuit "reemphasized the importance of the requirement that the reference describe not only the elements of the claimed invention, but also that it describe those elements 'arranged as in the claim'," citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).¹

For at least the above reasons, the rejection must be withdrawn.

2. The Examiner Incorrectly Cites More than One Reference In the Alleged Anticipation Rejection

The Examiner alleges that since "the rejection of claim does not refer to any *specific* patent or reference other than [sic: than] Hoffberg" it is appropriate to base the rejection on Col. 42, lines 20-67, which consists of a listing of fifty-one issued patents that Hoffberg seeks to incorporate by reference. (Examiner's Answer, page 11, emphasis supplied.) The rationale advanced by the Examiner is that this listing of other patents is properly considered in this anticipation rejection since the other patents are only listed "**as a demonstration** to the state of the art and what was know at the time of the filing of Hoffberg." (Examiner's Answer, page 11, emphasis in original.) To the contrary, MPEP 2131.01, which addresses citation of multiple references in anticipation rejections, does not include a 'state of the art' exception.

For this additional reason, the rejection must be withdrawn.

¹ A printout of the recent *Net MoneyIN, Inc. v. VeriSign, Inc.* decision is enclosed for the Examiner's convenience.

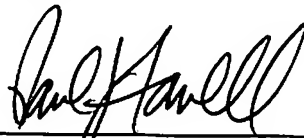
3. Conclusion

Appellant has shown that there are claimed features not disclosed by the cited reference, and has thus shown that Claims 1-7 and 109-141 have been erroneously rejected under 35 U.S.C. §102(b). For at least this reason the Examiner has not established a *prima facie* showing of anticipation and the rejection must be withdrawn.

Dated: December 4, 2008

Respectfully submitted,

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Enclosure: *Net MoneyIN, Inc. v. VeriSign, Inc.*, 2008 U.S. App. LEXIS 21827
(Fed. Cir. 2007-1565 Oct. 20, 2008).